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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,552	01/25/2002	Stephen L. Mayo	A-65353-9/RFT/RMS/RMK	3781
7590 02/25/2004				
ROBIN M. SILVA, ESQ. FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Four Embarcadero Center - Suite 3400 San Francisco, CA 94111-4187			EXAMINER KIM, YOUNG J	
			ART UNIT 1637	PAPER NUMBER

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S-AM

Office Action Summary**Application No.**

10/057,552

Applicant(s)

MAYO ET AL.

Examiner

Young J. Kim

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-30,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-30 and 32 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/7/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action responds the Amendment received on January 20, 2004.

Preliminary Remark

During the teleconference which occurred on February 18, 2004, Applicants' counsel, Ms. Morrison, was advised that the Terminal Disclaimer filed on January 20, 2004 with the Amendment/Response was disproved, resulting in the present communication.

The Office acknowledges the cancellation of claims 1-27 and 31, and the submission of new claim 33 in the Amendment received on January 20, 2004.

Claims 28-30, 32, and 33 are pending are under prosecution therefore.

Information Disclosure Statement

The references cited in the IDS received on October 7, 2002, particularly, references C2, C3, C4, and C5 had been considered at the time the previous Office Action was mailed (mailed on July 15, 2003). However due to an oversight, said references were not initialed in the corresponding PTO-1449. Therefore, said references have been initialed and the signed copy of the PTO-1449 is attached hereto.

Claim Objections

The objection of claims 4-20 for depending on a canceled claim, claim 1, made in the Office Action mailed on July 15, 2003 is withdrawn in view of the Amendment received on January 20, 2004, canceling the objected claims.

The objection of claims 12, 15, and 16 are objected to because the additional method steps are out of order, made in the Office Action mailed on July 15, 2003 is withdrawn in view of the Amendment received on January 20, 2004, canceling the objected claims.

Claim Rejections - 35 USC § 112

The rejection of claims 2-21 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, made in the Office Action mailed on July 15, 2003 is withdrawn in view of the Amendment received on January 20, 2004, canceling the rejected claims. In the previous Office Action, claims 1-21 were rejected under the statute. However, the rejection of claim 1 was due to a typographical error, as claim 1 had already been canceled in the preliminary amendment received on January 25, 2002.

The rejection of claims 17-21 under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement as the claims contained subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, made in the Office Action mailed on July 15, 2003 is withdrawn in view of the Amendment received on January 20, 2004, canceling the rejected claims.

Claim Rejections - 35 USC § 102

The rejection of claims 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hardman (U.S. Patent No. 4,939,666, issued July 3, 1990, IDS ref # A1), made in the Office

Action mailed on July 15, 2003 is withdrawn in view of the Amendment received on January 20, 2004, canceling the rejected claims.

Claim Rejections - 35 USC § 103

The rejection of claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardman (U.S. Patent No. 4,939,666, issued July 3, 1990, IDS ref # A1) in view of Lee et al. (U.S. Patent No. 5,241,470, issued August 31, 1993, IDS ref # A2), made in the Office Action mailed on July 15, 2003 is withdrawn in view of careful reconsideration of the Application and further in view of the arguments presented in the Amendment received on January 20, 2004, as Hardman patent does not teach or suggest using force field calculation in their method.

Double Patenting

The objection of claim 29 under 37 CFR 1.75 as being a substantial duplicate of claim 31, made in the Office Action mailed on July 15, 2003 is withdrawn in view of the Amendment received on January 20, 2004, canceling claim 31.

Maintained

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of claims 2-20, 30, and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-37, 39-48, 29, and 32 of copending Application No. 09/837,886, made in the Office Action mailed on July 15, 2003 is maintained for the reasons of record.

Applicants have filed a Terminal Disclaimer in order to overcome the rejection. However, the Terminal Disclaimer has been determined to be defective. Terminal Disclaimer has been found defective because the disclaimer did not specifically point out the patent/application number from which Applicants are disclaiming, rendering the claims rejected for the reasons made of record in the previous Office Action.

The rejection of claims 2-16, 28, 29, and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-15 of U.S. Patent No. 6,188,965 (issued February 31, 2001), made in the Office Action mailed on July 15, 2003 is maintained for the reasons of record.

Applicants have filed a Terminal Disclaimer in order to overcome the rejection. However, the Terminal Disclaimer has been determined to be defective. Terminal Disclaimer has been found defective because the disclaimer did not specifically point out the patent/application number from which Applicants are disclaiming, rendering the claims rejected for the reasons made of record in the previous Office Action.

New Rejection – Necessitated by Amendment

The present rejection is necessitated by the submission of new claim, claim 33, filed in the Amendment received on January 20, 2004.

Claim 33 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 30. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). For example, claim 30 is dependent on claims 28 or 29 and further comprises the step of, “identifying residues in at least one of said optimized protein sequences that differ from the starting backbone,” while claim 33 is also dependent on claim 29 with the same above limitation.

Canceling claim 33 would overcome this rejection.

Conclusion

No claims are allowed.

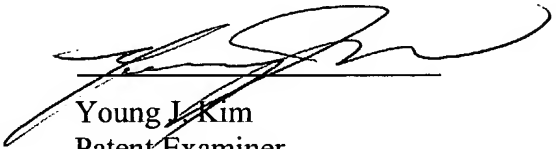
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. Monday through Thursday. If attempts to reach the Examiner by telephone are unsuccessful, the Primary Examiner in charge of the prosecution, Dr. Kenneth Horlick, can be reached at (571) 272-0784. If the attempts to reach the above Examiners are unsuccessful, the Examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782. Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993). (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (703) 872-9306. For Unofficial documents, faxes can be sent directly to the Examiner at (517) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0507.


Young J. Kim
Patent Examiner
Art Unit 1637
2/19/04


KENNETH R. HORLICK, PH.D.
PRIMARY EXAMINER

2/23/04